

9187104

1621



Docket No. 42982-C1-C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#9

APPLICANT: S. Goldin et al.

U.S. SERIAL NO.: 09/637,774

GROUP: 1621

FILED: August 11, 2000

EXAMINER: P. O'Sullivan

FOR: THERAPEUTIC GUANIDINES

**CERTIFICATE OF EXPRESS MAILING**

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on this date September 3, 2004 in an envelope as "Express Mail Post Office to Addressee," mailing Label Number EV437817717US addressed to the: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

By:

Michelle P. Chicos

Michelle P. Chicos

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

SEP 13 2004

Sir:

TECH CENTER 1600/2800

**PETITION TO WITHDRAW A HOLDING OF ABANDONMENT  
BASED ON FAILURE TO RECEIVE OFFICE ACTION (MPEP 711.03(c) I)**

Pursuant to 37 C.F.R. §1.181 and MPEP 711.03(c) I, Applicants respectfully petition for withdrawal of the holding of abandonment, which, as indicated on a Notice of Abandonment received by facsimile from the U.S. Patent & Trademark Office on July 26, 2004, was deemed to be abandoned for Applicants' alleged failure to timely file a response to an Office Action mailed on October 28, 2002.

As shown on the attached facsimile, the Attorneys of Record received a Notice of Abandonment by facsimile on July 26, 2004 (see last page). The Notice of Abandonment dated March 10, 2004 was sent to an old address, and therefore was not received by the Attorneys of Record. The Notice of Abandonment indicates that the application is abandoned for Applicants' alleged failure to timely file a response to an Office Action mailed on October 28, 2002.

The Attorneys of Record never received the Office Action mailed on October 28, 2002.  
A search of the file wrapper and docket records of the subject application confirms that **no** Office Action was received.

Also attached is the docket record as maintained by the Attorneys of Record for this case. There is no indication of an Office Action dated October 28, 2002. In fact, as shown on Page 2, the last entries on the docket correspond to the Office Action of March 27, 2002, for which a response was timely filed on June 27, 2002.

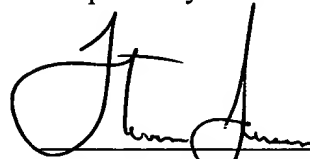
Further attached is a printout from Private Patent Application Information Retrieval (PAIR), which indicates that Applicants attempted to change the correspondence address for this application on several occasions, including at least on October 11, 2000; July 24, 2003; and April 20, 2004. The subject application is associated with Customer Number 21874, which enabled the Attorneys of Record to obtain the printout from Private PAIR.

Applicants respectfully request that the Commissioner, based on the foregoing statement of facts, withdraw the erroneous holding of abandonment and resend the Office Action.

The within petition and the related enclosures are being filed within two (2) months of the date on which Applicants received the Notice of Abandonment, and thus are believed to be timely filed (see 37 CFR 1.181(f)).

No fee is believed to be due in connection with the filing or consideration of this petition.  
In the event any fee is due, however, please charge such fee to Deposit Account No. **04-1105**.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'St. Jensen', written over a horizontal line.

Steven M. Jensen (Reg. No. 42,693)  
EDWARDS & ANGELL, LLP  
P.O. Box 55874  
Boston, MA 02205

Date: September 3, 2004

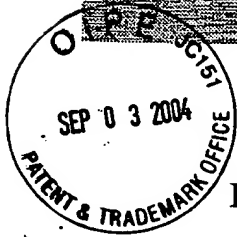
Phone: (617) 439-4444

Customer No. 21874

PFC/JDH 42982 CIC (47843)

Patent & Trademark Office  
Technology Center 1600  
400 Dulany Street  
Alexandria Campus  
Ramsen Bldg 4<sup>th</sup> Flr. D19  
Alexandria, Virginia

*J Hs1*



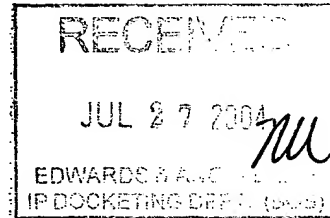
Facsimile Transmittal

Right Fax No. 571-273-0553  
Phone No. 571-272-0553

NOTED ON SYSTEM

Attn: Dike, Bronstein, Roberts &  
Cushman

Fax: 617-439-4170



Margaret Stevens

Date: July 20, 2004

*petition to withdraw aband.*  
Edwards & Angell LLP

101 Federal St. Boston, MA 02110

Docketed For *8/20/04-9/20/04*

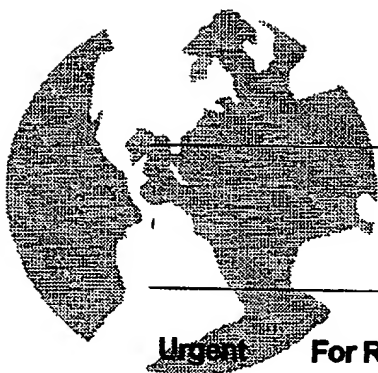
By *MU*

Approved \_\_\_\_\_

CONFIDENTIAL

Re: Application No 09/637,774

Pages: 5



**Urgent**

**For Review**

**Please Comment**

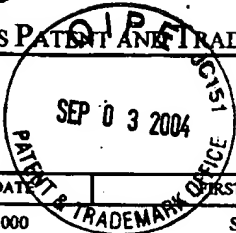
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/637,774	08/11/2000	Stanley M. Goldin	42,982-C1-C (1095)	1361

7590 03/10/2004

DIKE BRONSTEIN ROBERTS & CUSHMAN  
INTELLECTUAL PROPERTY PRACTICE GROUP  
130 WATER STREET  
BOSTON, MA 02109

EXAMINER
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O SULLIVAN, PETER G

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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TECH CENTER 1600/2000

**Notice of Abandonment**

Application No.

09/637,774

Examiner

Peter G O'Sullivan

Applicant(s)

GOLDIN ET AL.

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

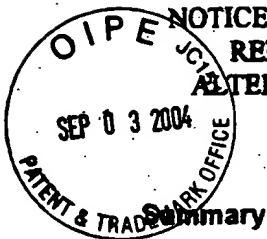
1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 28 October 2002.
  - (a) ☐ A reply was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply (including a total extension of time of \_\_\_\_\_ month(s)) which expired on \_\_\_\_\_.
  - (b) ☐ A proposed reply was received on \_\_\_\_\_, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.  
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
  - (c) ☐ A reply was received on \_\_\_\_\_ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
  - (d) ☒ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
  - (a) ☐ The issue fee and publication fee, if applicable, was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
  - (b) ☐ The submitted fee of \$\_\_\_\_\_ is insufficient. A balance of \$\_\_\_\_\_ is due.  
The issue fee required by 37 CFR 1.18 is \$\_\_\_\_\_. The publication fee, if required by 37 CFR 1.18(d), is \$\_\_\_\_\_.
  - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
  - (a) ☐ Proposed corrected drawings were received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply.
  - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on \_\_\_\_\_ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:

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TECH CENTER 1600/2900

PETER G'SULLIVAN  
PRIMARY EXAMINER  
GROUP 1200

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.



**NOTICE OF OFFICE PLAN TO CEASE SUPPLYING COPIES OF CITED U.S. PATENT REFERENCES WITH OFFICE ACTIONS, AND PILOT TO EVALUATE THE ALTERNATIVE OF PROVIDING ELECTRONIC ACCESS TO SUCH U.S. PATENT REFERENCES**

The United States Patent and Trademark Office (Office or USPTO) plans in the near future to: (1) cease mailing copies of U.S. patents and U.S. patent application publications (US patent references) with Office actions except for citations made during the international stage of an international application under the Patent Cooperation Treaty and those made during reexamination proceedings; and (2) provide electronic access to, with convenient downloading capability of, the US patent references cited in an Office action via the Office's private Patent Application Information Retrieval (PAIR) system which has a new feature called "E-Patent Reference." Before ceasing to provide copies of U.S. patent references with Office actions, the Office shall test the feasibility of the E-Patent Reference feature by conducting a two-month pilot project starting with Office actions mailed after December 1, 2003. The Office shall evaluate the pilot project and publish the results in a notice which will be posted on the Office's web site ([www.USPTO.gov](http://www.USPTO.gov)) and in the Patent Official Gazette (O.G.). In order to use the new E-Patent Reference feature during the pilot period, or when the Office ceases to send copies of U.S. patent references with Office actions, the applicant must: (1) obtain a digital certificate from the Office; (2) obtain a customer number from the Office, and (3) properly associate applications with the customer number. The pilot project does not involve or affect the current Office practice of supplying paper copies of foreign patent documents and non-patent literature with Office actions. Paper copies of references will continue to be provided by the USPTO for searches and written opinions prepared by the USPTO for international applications during the international stage and for reexamination proceedings.

**Description of Pilot Project to Provide Electronic Access to Cited U.S. Patent References**

On December 1, 2003, the Office will make available a new feature, E-Patent Reference, in the Office's private PAIR system, to allow more convenient downloading of U.S. patents and U.S. patent application publications. The new feature will allow an authorized user of private PAIR to download some or all of the U.S. patents and U.S. patent application publications cited by an examiner on form PTO-892 in Office actions, as well as U.S. patents and U.S. patent application publications submitted by applicants on form PTO/SB08 (1449) as part of an IDS. The retrieval of some or all of the documents may be performed in one downloading step with the documents encoded as Adobe Portable Document format (.pdf) files, which is an improvement over the current page-by-page retrieval capability from other USPTO systems.

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1600/2900



references. The Office plans to continue to provide access to the E-Patent Reference feature during its evaluation of the pilot.

#### Comments

Comments concerning the E-Patent Reference feature should be in writing and directed to the Electronic Business Center (EBC) at the USPTO by electronic mail at [eReference@uspto.gov](mailto:eReference@uspto.gov) or by facsimile to (703) 308-2840. Comments will be posted and made available for public inspection. To ensure that comments are considered in the evaluation of the pilot project, comments should be submitted in writing by January 15, 2004.

Comments with respect to specific applications should be sent to the Technology Centers' customer service centers. Comments concerning digital certificates, customer numbers, and associating customer numbers with applications should be sent to the Electronic Business Center (EBC) at the USPTO by facsimile at (703) 308-2840 or by e-mail at [EBC@uspto.gov](mailto:EBC@uspto.gov).

#### Implementation after Pilot

After the pilot, its evaluation, and publication of a subsequent notice as indicated above, the Office expects to implement its plan to cease mailing paper copies of U.S. patent references cited during examination of non provisional applications on or after February 2, 2004; although copies of cited foreign patent documents, as well as non-patent literature, will still be mailed to the applicant until such time as substantially all applications have been scanned into IFW.

#### For Further Information Contact

Technical information on the operation of the IFW system can be found on the USPTO website at <http://www.uspto.gov/web/patents/ifw/index.html>. Comments concerning the E-Patent Reference feature and questions concerning the operation of the PAIR system should be directed to the EBC at the USPTO at (866) 217-9197. The EBC may also be contacted by facsimile at (703) 308-2840 or by e-mail at [EBC@uspto.gov](mailto:EBC@uspto.gov).

Date. 12/1/03



Nicholas P. Godici  
Commissioner for Patents

## **Steps to Use the New E-Patent Reference Feature During the Pilot Project and Thereafter**

Access to private PAIR is required to utilize E-Patent Reference. If you don't already have access to private PAIR, the Office urges practitioners, and applicants not represented by a practitioner, to take advantage of the transition period to obtain a no-cost USPTO Public Key Infrastructure (PKI) digital certificate, obtain a USPTO customer number, associate all of their pending and new application filings with their customer number, install no-cost software (supplied by the Office) required to access private PAIR and E-Patent Reference feature, and make appropriate arrangements for Internet access. The full instructions for obtaining a PKI digital certificate are available at the Office's Electronic Business Center (EBC) web page at: <http://www.uspto.gov/ebc/downloads.html>. Note that a notarized signature will be required to obtain a digital certificate.

To get a Customer Number, download and complete the Customer Number Request form, PTO-SB125, at: <http://www.uspto.gov/web/forms/sb0125.pdf>. The completed form can then be transmitted by facsimile to the Electronic Business Center at (703) 308-2840, or mailed to the address on the form. If you are a registered attorney or patent agent, then your registration number must be associated with your customer number. This is accomplished by adding your registration number to the Customer Number Request form. A description of associating a customer number with an application is described at the EBC web page at: [http://www.uspto.gov/ebc/registration\\_pair.html](http://www.uspto.gov/ebc/registration_pair.html).

The E-Patent Reference feature will be accessed using a new button on the private PAIR screen. Ordinarily all of the cited U.S. patent and U.S. patent application publication references will be available over the Internet using the Office's new E-Patent Reference feature. The size of the references to be downloaded will be displayed by E-Patent Reference so the download time can be estimated. Applicants and registered practitioners can select to download all of the references or any combination of cited references. Selected references will be downloaded as complete documents as Adobe Portable Document Format (.pdf) files. For a limited period of time, the USPTO will include a copy of this notice with Office actions to encourage applicants to use this new feature and, if needed, to take the steps outlined above in order to be able to utilize this new feature during the pilot and thereafter.

During the two-month pilot, the Office will evaluate the stability and capacity of the E-Patent Reference feature to reliably provide electronic access to cited U.S. patent and U.S. patent application publication references. While copies of U.S. patent and U.S. patent application publication references cited by examiners will continue to be mailed with Office actions during the pilot project, applicants are encouraged to use the private PAIR and the E-Patent Reference feature to electronically access and download cited U.S. patent and U.S. patent application publication references so the Office will be able to objectively evaluate its performance. The public is encouraged to submit comments to the Office on the usability and performance of the E-Patent Reference feature during the pilot. Further, during the pilot period registered practitioners, and applicants not represented by a practitioner, are encouraged to experiment with the feature, develop a proficiency in using the feature, and establish new internal processes for using the new access to the cited U.S. patents and U.S. patent application publications to prepare for the anticipated cessation of the current Office practice of supplying copies of such cited

## TRANSACTION REPORT

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